

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)	Confirmation No: 9260
Paul S. Enfield)	
Application No. 09/902,923)	Examiner: Elaine L. Gort
Filed: July 10, 2001)	Group Art Unit: 3687
For: INFORMATION, DIRECTORY,)	
LOCATION AND ORIENTATION)	
SYSTEM FOR RETAIL STORES AND)	
THE LIKE)	Date: April 7, 2009

RESPONSE AND SUBMISSION OF DECLARATION PRIOR TO APPEAL

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the RCE filed on July 11, 2008, the Office issued a final Office Action on October 9, 2008, which maintains the rejection of claims 17 to 27 under 35 U.S.C. § 103(a), as allegedly being unpatentable over Ramey (U.S. Patent No. 5,297,685, hereinafter "Ramey") in view of Begum et al. (U.S. Patent No. 6,012,244, hereinafter "Begum"), the Porter et al. article, "The influence of brand recognition on retail store image," The Journal of Product and Brand Management, Santa Barbara, 1997, Vol. 6, No. 6, page 373 (hereinafter, "Porter"), and Official Notice taken by the Examiner. More specifically, section 3 of the final Action, which spans pages 2 through 12, repeats the prior rejection word-for-word, and Applicant's Response filed along with the RCE on July 11, 2008, rebuts the Office's allegations made in section 3. Those remarks are incorporated herein by reference, and Applicant reserves the right to re-present those arguments on appeal, if necessary.

With respect to the Declarations Under 37 C.F.R. § 1.132 by Paul Enfield and David Weber presenting objective indicia of nonobviousness, the Examiner asserts, at page 14 of the Action, that these declarations fail to show clear evidence of unexpected results sufficient to overcome the rejection of the claims because the study on which the declarations are based is not included. Additionally, the Examiner appears to suggest that the evidence supplied

with the declarations is not within the scope of the claimed subject matter. More specifically, the Examiner asserts that the results of increased sales may be linked to many other variables outside the specifically claimed signage within the store, and that the amount of the increase in brand name sales has not been proven to exceed well known targeted point of sale advertising (such as simply displaying a “coke” ad above an aisle). In response to these concerns, Applicant submits herewith a Third Declaration of Paul Enfield Under 37 C.F.R. § 1.132.

In this declaration, the above-identified inventor, Paul Enfield, explains at length the details of the study yielding the unexpected results, how the results were obtained, and why the magnitude of the results of increased sales in dry goods is unexpected. The declaration also explains *inter alia* that the figures of present application include photographs of aisles of the actual store used in the study, and that the store, store aisles (i.e., dry goods aisles) and signs shown in these photographs are commensurate with the subject matter recited in the pending independent claims. It is respectfully submitted that this declaration of Mr. Enfield adequately addresses the Examiner’s concerns regarding the variables identified in the final Office Action, and further explains that no other variables existed outside the signage within the store that could reasonably be considered significant to the study, or would have any significant effect on the study’s results. Furthermore, the declaration explains that the 34 stores in the study other than the store with the claimed signage (i.e., the East Wenatchee store) used signs showing only text product descriptions, which are equivalent to the industry standard, did not employ the claimed signage, and that all 35 stores in the study used common pricing, advertising and product mix as they are placed on the shelves.

Finally, during a telephone conference between the undersigned and the Examiner on August 29, 2008, the Examiner identified a reference entitled “Grimm Faces Pace Renewal Task: New Prototype, Store Labels, Reduced Skus,” by Laura Liebeck, dated September 20, 1993, and on the same day provided the undersigned with an electronic copy of that document in an email correspondence. However, the Examiner made no mention of this document in the most recent final Office Action. It is respectfully requested that the Examiner list this reference on a PTO Form 892, enter it into the official record, and provide a copy of this form to Applicant. Furthermore, it is requested that if the Examiner considers this document relevant to the claimed subject matter, she provide Applicant a written, official

explanation consistent with the requirements under Rule 104.

For all the foregoing reasons, and reasons set forth in the July 11, 2008, Response, the September 21, 2007, Amendment, the September 11, 2006, Response, and all declarations by Paul Enfield and David Weber pursuant to 37 C.F.R. § 1.132, Applicant requests withdrawal of the pending rejection of claims 17 to 27 under Section 103(a) and prompt allowance of the present application.

However, if the Examiner intends on maintaining the pending rejection, Applicant requests that the Examiner promptly consider the declaration submitted herewith and notify Applicant of the application status via an advisory action.

Respectfully submitted,

/John F. Guay, Reg. No. 47,248/
John F. Guay

John F. Guay, LLC
1523 Michigan Avenue, NE
Washington, DC 20017-2737
202-510-9742 (Direct)
202-747-5726 (Fax)

c/o Hughes Law Firm, PLLC
Pacific Meridian Plaza
4164 Meridian Street, Suite 302
Bellingham, WA 98226
360-647-1296
230-671-2489 (Fax)